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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,565	01/05/2004	Masaaki Ueda	17339	3667

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SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER

JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
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3739

MAIL DATE	DELIVERY MODE
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12/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/751,565

Applicant(s)

UEDA ET AL.

Examiner

Henry M. Johnson, III

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,9,13,15,20,22 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10-12,14,16-19,21,23-25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 22, 2007 has been entered.

Response to Arguments

Applicant's arguments have been fully considered and are persuasive with respect to rejections under 35 U.S.C. § 102 and the rejections have been changed to rejections under 35 U.S.C. § 103. Shimmura et al., like the Applicant, disclose an instrument holder with multiple degrees of movement to provide the flexibility required in the surgical arena including various joints and a ball joint. The examiner takes the position that since various surgical procedures require differing instrument positioning to provide access, a skilled artisan would be motivated to modify the holder to provide such access or to combine the basic holder with an adjustable holder such as U.S. Patent 5,957,423 to provide multiple instrument orientations with respect to the operating site.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 27 and 30 recite the limitation of the ball joint axis being parallel to the instrument axis rendering the claim indefinite as the instrument axis is not fixed due to the ability to incline as well as rotate with the ball joint.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25, and 27-34 are rejected under 35

U.S.C. 103(a) as being unpatentable
over U.S. Patent Application
Publication US 2001/0027313 to
Shimmura et al. in view of U.S.
Patent 5,957,423 to Kronner.
Shimmura et al. teach a medical

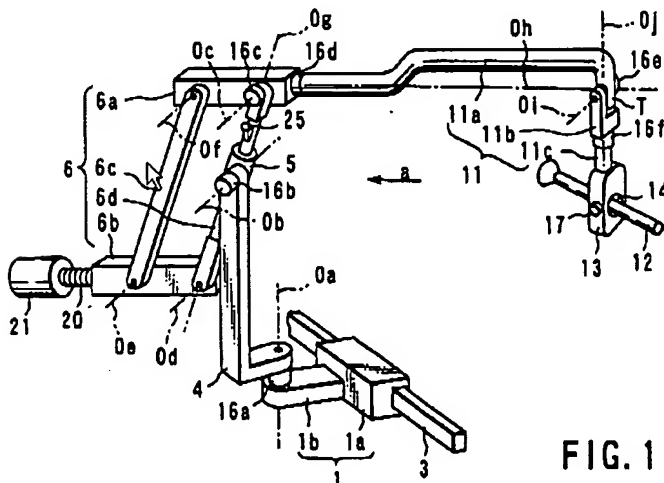


FIG. 1

instrument holding apparatus with a portion for holding an instrument (Fig. 1, # 14), a support arm (Fig. 1, # 11a), a base support (basal portion, Fig. 1, #s 3 & 4), a shaft coupled to the basal support (Fig. 1, # 4), the shaft forming part of a parallelogram moving (moving mechanism) structure (Fig. 1, # 6) with a counterweight (Fig. 1, # 21) to offset the weight of the support arm (Fig. 1, # 11a) and instrument. Multiple axes of rotation within the supporting mechanism are disclosed (Fig. 1, #s 0a – 0j). Arm 6a is clearly shorter than arm 6c of the parallelogram. A ball joint is disclosed that connects the moving portion to an instrument support portion (Fig. 7, #16h). The support shaft (Fig. 1, # 11a) has an axis-of-rotation (0h), inherently allowing the ball joint to be above, below or on a horizontal plane with the instrument holding means. As the angle of inclination within the ball joint changes, so will the position of the center of gravity, said center of gravity also being dependent on the size and weight distribution of the instrument. Since the center of gravity of the instrument and support depends on the instrument and the orientation, the ball joint is clearly capable of being oriented in any relation to the center of gravity. An operator may grasp any portion of the support and instrument elements. Electromagnetic locks as means for braking their respective movable sections are disclosed (Fig. 1, #s 16a-16f), with an activating switch on the holding portion (paragraph 0059). A braking means is also disclosed for the ball joint (paragraph 0092). The instrument holding portion is interpreted is capable of being held by an operator and is coupled to the support arm by rotatable joints (Fig. 1, #s 16e & 16f). The upper portion of the parallelogram is shorter than the lower portion with the counterweight and either of the side arms. The counterweight is adjustable via screw threads (Fig. 1, # 20). The apparatus of Shimmura et al. implicitly has centers of gravity, centers of inclination and forces exerted within the device based on the weights of the instrument and counterweights. Relative positions of apparatus components will vary as the instrument is positioned and can assume limitless configurations. The apparatus is

therefore interpreted as capable of the position(s) cited. Shimmura et al. do not specifically teach an instrument holder capable of achieving an instrument axis parallel to the rotation axis of a ball joint. Kronner discloses an adjustable instrument holder that allows an instrument to assume a variety of positions as might be required during a surgical process. The positioning of the instrument is based on the intended use and a skilled artisan would clearly be motivated to combine the adjustable holder of Kronner with the device of Shimmura et al. to achieve the desired positioning of the instrument.

Regarding claim 2, the position of the brake switch is considered a design choice within the skill of the art. Both foot switches and hand switches are common in the art.

Regarding claims 33 and 34, a skilled artisan knows that endoscopes typically include multiple lumens for instruments and observation during an endoscopic procedure. It would have been obvious to one skilled in the art to include optics and imaging in the instrument as it is common and well known to do so.

Allowable Subject Matter

Claims 7, 9, 13, 15, 20, 22 and 26 are allowed.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Henry M. Johnson, III
Primary Examiner
Art Unit 3739